REMARKS

I. Preliminary Remarks

Claims 1-13 are currently pending. This application is a continuation of U.S. Application Serial No. 09/341,915 filed July 20, 1999 which issued as U.S. Patent No. 6,653,299. Independent claim 1 has been amended to specify a metal chelating agent of specified structure. This amendment is supported by the disclosure of the application at page 4, lines 20-24 and at page 5, lines 24-29 of the specification and no new matter is introduced thereby. In addition, claim 6 has been cancelled and claim 7 (which depended from claim 6) has been amended to correct its dependency.

II. Outstanding Rejections

Claims 1-13 stand rejected under 35 U.S.C. § 112(second paragraph) as being indefinite.

Claims 4-13 stand rejected under 35 U.S.C. § 112(fifth paragraph) as being improperly multiply dependent.

Claims 1 and 2 stand rejected under 35 U.S.C. §101 over claims 1 and 2 of U.S. Patent No. 6,653,299 for double patenting.

Claims 3-13 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,653,299.

III. Patentability Arguments

A. The Rejection Under 35 U.S.C. §112(second paragraph) Should be Withdrawn.

The rejection of claims 1-13 under 35 U.S.C. §112 (second paragraph) should be withdrawn in light of the amendment submitted herewith in which the metal chelating agent

is structurally defined. This amendment is supported in the specification such as at page 4, lines 20-24 and at page 5, lines 24-29. Accordingly, the rejection under under 35 U.S.C. §112 (second paragraph) should be withdrawn.

B. The Rejection Under 35 U.S.C. §112(fifth paragraph) Should be Withdrawn.

The rejection of claims 4-13 under 35 U.S.C. §112 (fifth paragraph) for improper multiple dependencies should be withdrawn as there no longer exist multiple dependencies in the pending claims. The Examiner's attention is directed to the preliminary amendment filed August 23, 2003 in which the multiple dependencies in the claims originally filed in the parent application were corrected.

C. The Rejection Under 35 U.S.C. §101 Should be Withdrawn.

The double patenting rejection under 35 U.S.C. §101 over the claims of parent patent U.S. 6,653,299 should be withdrawn in light of the amendment of claim 1 submitted herewith in which claims 1 and 2 of the present application are different from those of U.S. 6,653,299. Moreover, the rejection need not have been originally made because the claims of U.S. 6,653,299 were misprinted (they are currently subject to a certificate of correction) and were not the same as those originally filed in the present application.

D. The Obviousness-type Double Patenting Rejection Should be Withdrawn.

The obviousness-type double patenting rejection of claims 3-13 over claims 1-13 of U.S. 6,653,299 should be withdrawn in light of the terminal disclaimer submitted herewith. Moreover, no new obviousness-type double patenting rejection of claims 1 and 2 should be made as well. The required fee of $130.00 under 37 CFR 1.20(d) is submitted herewith.

CONCLUSION

For all of the foregoing reasons, the rejections should now be withdrawn and an notice of allowance of all pending claims (1-5 and 7-13) is respectfully solicited. Should the Examiner wish to discuss any issues of form or substance in order to expedite allowance of the pending application, he is invited to contact the undersigned attorney at the number indicated below.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606
312-474-6300

By: _____
Jeffrey S. Sharp
Registration No. 31,879
Attorney for Applicants

December 15, 2004